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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,608	12/05/2005	Michal Hocek	4367-0107PUS1	3490
2292	7590	10/23/2008	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			BERCH, MARK L	
			ART UNIT	PAPER NUMBER
			1624	
			NOTIFICATION DATE	DELIVERY MODE
			10/23/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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mailroom@bskb.com

DETAILED ACTION

The amendment filed under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance and will not be entered because: The proposed amendment raises new issues that would require further consideration and/or search.

The proposed amendment to claim 1 would introduce several problems. The removal of the ambiguous “benzophenoneimine” choice without replacement with some other “imine” choice would mean that claim 2 would be improperly dependent on claim 1, since claim 2 requires that the compound be an imine. Second, the wording that R¹R²N is “diphenylmethylamino” is ambiguous, since it could mean either (diphenyl)(methyl)amino or it could mean di(phenylmethyl)amino. Third, in either case, it lacks description in the specification. Applicants point to the specification at page 6, lines 25-28, but Applicants are confused; that compound would not even fall within formula 1 of claim 1. That compound has a “(diphenylmethylenamino)” group, but regardless of which of the above choices is intended, neither one has a methylenamino group. A methylenamino group requires a carbon with a double bond; in the page 6 molecule, the methylenamino is attached to an amino to form an imine. Claim 1, as proposed, has no imine.

The traverse is unpersuasive on the enablement rejection. Applicants state, “Applicants wish to point out to the Examiner that what is being sought to be patented is not a method of use. Rather, Applicants seek a patent covering the claims of the present invention, which are directed to compounds, not viruses, cancers, or treatment thereof.” The examiner is aware of this and said so explicitly in the previous action. However, all claims must be enabled, regardless of type. The only difference between enablement of

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compounds and enablement of methods of use is that methods must be enabled for the scope of methods recited in the claim, while the compounds need only a single utility to be enabled. Thus, while applicants say, "Applicants' claims are not directed to any cancers or viruses", those two items, alone with the vague "intermediate", is all that the specification teaches as the use of the compounds. But there must be that utility. Applicants attention is against directed to *In re Gardner, Roe, and Willey*, 166 USPQ 138, claims 1 and 2, and to *In re Vaeck*, 20 USPQ2d 1438, claim 1, in which the composition of matter (not method) claims were held to lack enablement because they lacked an enabling utility. Applicants cannot brush aside the enablement requirement in terms of how to use simply because the claims are not method claims.

With regard to WO 00/75158, as was stated previously: "This cannot possibly suffice. The compounds are too different. The WIPO publication is entitled "NOVEL 6-PHENYLPURINE 9- β -D-RIBONUCLEOSIDES". These compounds have at the 6-position a mandatory phenyl ring with up to three optional substituents. These substituents do not include applicants' amino acid or anything even similar (i.e. do not include amino or acid as a substituent on an alkyl). In fact, applicants aren't even required to have a 6-phenyl group at all, and indeed most compound claims i.e. 2, 3, 5-8 don't even permit a phenyl!!

Further, the compounds of the reference are ribonucleosides. Applicants compounds are not required to be ribonucleosides. Indeed, the great majority of the species in the instant specification were not ribonucleosides." To this, applicants respond with three arguments:

A. "the specification is replete with examples of compounds containing phenyl groups."

True, but it is the claims which must be enabled. For claim 2, which cannot have phenyl

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group at the 6-position (i.e. has $n=0$), a reference which is limited to compounds which must have a phenyl group at the 6-position is irrelevant.

B. "in fact, the present claim 2 has been amended to explicitly recite a phenyl group." This is confused. The phenyl at the 6-position corresponds to $A=\text{phenyl}$, $n=1$. The proposed amendment to claim 2 would not have put that material into claim 2, and even if it had, that would be irrelevant to claim 3 etc.

C. Applicants argue in the middle of page 11 that this reference (and also the newly cited Capek reference) teach how to make the compounds, but the enablement rejection here is in terms of how to use the compounds, not how to make the compounds. Also, the Cepak reference is later than the filing date and hence cannot be relied upon to establish enablement. If applicants wish to make the reference of record, a proper 1449 must be submitted.

With regard to claims 9-12, applicants argue that these are method of making claims. Correct, but a method of making a compound is not enabled if there is no enabling utility for the compound itself. See *Brenner v. Manson*, 383 U.S. 519, 148 USPQ 689.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to /Mark L. Berch/ whose telephone number is 571-272-0663. The examiner can normally be reached on M-F 7:15 - 3:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on (571)272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/Mark L. Berch/
Primary Examiner
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10/22/2008